

TRANSMITTAL OF APPEAL BRIEF (Large Entity)

Docket No.
1421-58 DIV

In Re Application Of: APPARATUS FOR MAKING A CENTER-FILLED GUM LOLLIPOP WITH HARD CANDY SHELL

Application No.	Filing Date	Examiner	Customer No.	Group Art Unit	Confirmation No.
10/664,426	August 26, 2003	S.L. Kuhns	23869	1761	4538

Invention: APPARATUS FOR MAKING A CENTER-FILLED GUM LOLLIPOP WITH HARD CANY SHELL

COMMISSIONER FOR PATENTS:

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Dated: March 27, 2006

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IA

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellant(s): Jani, et al.

Examiner: Kuhns, S. L.

Application: 10/664,426

Group Art Unit: 1761

Filed: August 26, 2003

Docket: 1421-58 DIV

Confirmation No: 4538

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For: APPARATUS FOR MAKING A
CENTER-FILLED GUM LOLLIPOP
WITH HARD CANDY SHELL

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APPEAL BRIEF PURSUANT TO 37 CFR §41.37

Sir:

This is an appeal to the Board of Appeals from an Action mailed August 26, 2005 marked final and the subsequent Advisory Action mailed January 5, 2006, in which the Examiner finally rejected Claims 22-24 of the above-identified application. Appellants timely filed a Notice of Appeal on January 24, 2006. This Notice of Appeal was received at the U.S. Patent and Trademark Office on January 27, 2006. Therefore, the due date for filing the Appeal Brief is Monday, March 27, 2006. This brief is being filed in support of that Notice of Appeal.

As required by 37 C.F.R. §41.37, a single copy of this brief is being filed with the filing fee of \$500.00. Please charge the fee to Deposit Account No. 08-2461. Kindly charge or credit any fees or overpayments, respectively, to Deposit Account No. 08-2461.

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1. REAL PARTY IN INTEREST

The real party in interest in the present appeal is Cadbury Adams USA LLC, a company registered in the state of New Jersey, having acquired rights by way of an assignment recorded in the United States Patent and Trademark Office at Reel 014108, Frame 0261.

2. RELATED APPEALS AND INTERFERENCES

No related appeals or interferences are known to Appellants or Appellants' legal representative which will directly affect or be directly affected by or have bearing on the Board's decision in this appeal.

3. STATUS OF THE CLAIMS

Claims 22-24 are presently pending in the application. Claims 22-24 stand finally rejected. The rejections of 22-24 are being appealed.

Claims 18-21 have been rejected under 35 U.S.C. §103 as allegedly unpatentable over 4,250,196 to Friello ("Friello") in view of U.S. Patent No. 3,062,662 to McDonald ("McDonald").

4. STATUS OF AMENDMENTS

No amendments have been made to the claims subsequent to the final rejection.

5. SUMMARY OF CLAIMED SUBJECT MATTER

The present invention includes a three-material confection which includes a center layer of a semi-liquid material, an intermediate layer of a gum material and an outer layer of a hard candy material. The candy may also be in the form of a lollipop. The present invention has prepared this lollipop product by addressing and compensating for the issues related to center-fill

gums, such as leaking and liquid migration from the center-fill which results in a non-liquid center.

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The issue on appeal includes:

- I. Are Claims 22-24 obvious over Friello in view McDonald?

7. ARGUMENTS

- I. Claims 22-24 are patentable over Friello in view McDonald.

Claims 22-24 have been rejected under 35 U.S.C. §103 as allegedly unpatentable over 4,250,196 to Friello ("Friello") in view of U.S. Patent No. 3,062,662 to McDonald. Appellants respectfully traverse these rejections on the grounds that the Examiner has failed to establish a *prima facie* case of obviousness. Specifically, the references include no motivation to modify or combine the references, the teachings of the references are not properly combinable, and even if combined, the references fail to teach the invention as claimed. Therefore, reconsideration and withdrawal of the rejections are respectfully requested.

M.P.E.P §2143 states the "Basic Requirements of a *Prima Facie* Case of Obviousness. In order to establish a *prima facie* case of obviousness, (1) a reference or combination of references must provide some suggestion or motivation to modify the reference or to combine the teachings; (2) there must be a reasonable expectation of success; and (3) there must be a teaching or suggestions of all claim limitations. The teachings must consider the reference as a whole and the proposed modification cannot render the prior art unsatisfactory for its intended purpose.

The deficiencies of the references to establish a *prima facie* case of obviousness are:

(1) neither Friello nor McDonald includes any teaching or suggestion to modify or combine the references; (2) even if the teachings of Friello and McDonald are combined, they would not result in a three layered confection as in the present invention; and (3) neither Friello nor McDonald teaches a gum layer which is a separate layer surrounded by a hard candy layer.

Friello teaches a center-filled gum composition having a liquid center. The formulation of the center-fill allows for the use of an aqueous solution including a hydrogenated starch hydrolysate which avoids the need for addition of glycerin. Friello recognizes the inherent problems of providing a commercially acceptable center-filled gum such as potential leaking and hardening of the center-fill. The focus of the teachings of Friello is to provide an acceptable gum product which provides the benefit of a liquid center gum to the consumer. Friello provides no teaching or suggestion to add any coating to the gum composition, nor how such a coating may be accomplished.

McDonald is cited for teaching a combination of chewing gum and candy in a lollipop form. McDonald prepares this confection by inserting a lollipop stick into a gum piece and then dipping the gum into a hot candy syrup. The gum must stay in the syrup for a sufficient time "so that the bubble gum will partially melt and soften and mix with the candy." Column 2, lines 54-55. The purpose of McDonald is to provide a combination of candy and gum where "the candy composition intermixes with a substantial part of the bubble gum material." Column 1, lines 35-36.

The Examiner states at page 2 of the Office Action date August 26, 2005 that the motivation to combine the references is "in order to provide the product with an additional appealing texture and/or flavor and also to extend the period of time over which the produce could be enjoyed." This teaching is not found in either Friello or McDonald, but instead is the

purpose of the present invention and in effect is nothing more than impermissible hindsight reconstruction. It is well-settled as expressed in MPEP §2143, "[t]he teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure."

As the Board has stated,

...we note that it is impermissible to use the claimed invention as an instruction manual or "template" to piece together isolated disclosures and teachings of the prior art so that the claimed invention may be rendered obvious. We additionally note that a rejection based on Section 103 must rest on a factual basis, with the facts being interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, the examiner has the initial duty of supplying the factual basis for the rejection he advances. He may not, because he doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis.

Ex parte Haymond, 41 U.S.P.Q.2d 1217, 1220 (B.P.A.I. 1996) (citation omitted).

Considering that neither Friello nor McDonald provides motivation to modify the teachings therein to provide a hard candy coating on a liquid filled chewing gum, the combination of Friello and McDonald fails to establish a *prima facie* case of obviousness.

The second requirement for establishing a *prima facie* case of obviousness is that the references must provide a reasonable expectation of success. In the Office Action dated August 26, 2005, at pages 2-3, the Examiner does not seem to acknowledge this criteria. Instead, the Examiner states:

the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; not is it that the claimed invention must be expressly suggested in any one or all of the references.

Rather the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*; 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Appellants do not deny that what the teachings of a reference suggest to those of ordinary skill in the art is an important consideration. However, this does not negate the requirement that there must be a reasonable expectation of success. One following the teachings of the references will not achieve the product of the present invention. Therefore, there is no reasonable expectation of success.

As pointed out in the response dated July 11, 2005, even if one were to combine the teachings of McDonald with Friello, one could not expect to achieve a successful candy-coated center-filled product as in the present invention. McDonald does not contemplate the inclusion of a center-filled gum and therefore does not accommodate for the potential issues of leaking or moisture migration of the center. Melting the gum layer as required by McDonald would lead to a non-homogeneous layer adjacent to the liquid center that could result in leaking of the liquid center which is contained by the gum. Furthermore, the combination of the candy layer with the gum layer would likely eliminate the separate intermediate gum layer, as the gum would be combined with the hard candy.

McDonald requires the combination of a gum with the candy by melting the gum and candy together. McDonald is concerned only with solid gum centers which are dipped into hot (300 – 310F) candy syrup. It is clear from the teachings of McDonald that this dipping process was not intended for liquid-center-filled gums since to allow partial melting and softening of the candy with the gum and to impregnate the gum with hard candy crystals will unpredictably disrupt the gum layer and jeopardize the integrity of the center-filled gum. Furthermore, the melting process as set forth in McDonald is not a controlled process. The mixture of candy coating and gum would likely be unevenly distributed given the lack of control. This is in

contrast to the present invention in that the present invention has three distinct and separate layers.

In addition, prevention of center fill leaking is addressed in Friello's requirement for a water impenetrable gum base (*see* column 5, lines 15-16). Impregnating the gum with hard candy crystals as in McDonald could disrupt the water impenetrable gum base material. As the Examiner is aware, there are many difficulties in producing and maintaining commercially viable center-filled gums and one of ordinary skill in the art would avoid processes which might introduce additional problems such as premature migration. Thus one of ordinary skill in the art would not employ the process as taught by McDonald to coat a center-filled gum since using the method of McDonald would not provide one of ordinary skill in the art with a reasonable expectation of success.

Also, as discussed above, neither McDonald nor Friello provides a teaching or suggestion to provide a hard candy layer and an intermediate gum layer. The only teaching of a hard candy in combination with a gum layer is found in McDonald, wherein there are not two layers, but to the contrary, the gum and hard candy are mixed.

For the reasons set forth above, there is no motivation in any of the references to combine the teachings of each. Even if combined, the references would not lead one of ordinary skill in the art to prepare the invention of the present claims.

In view of the above amendments and remarks, Appellants respectfully submit that the present application, including claims 22-24 is now in condition for allowance. Favorable action thereon is respectfully requested.

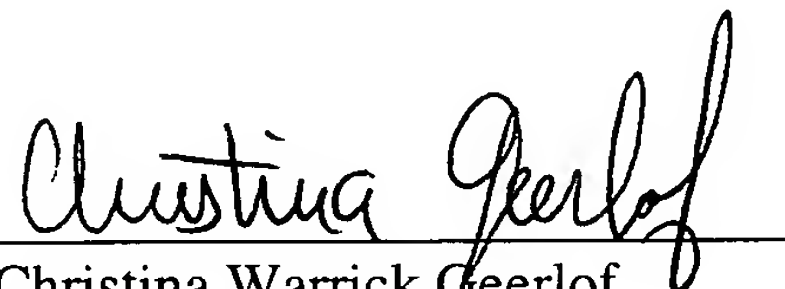
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8. CONCLUSION

Having set forth factual and legal basis which support the patentability of the claims on appeal, it is respectfully submitted that Claims 22-24 are in condition for allowance.

Accordingly, Appellants respectfully urge the Board to reverse the Examiner's rejections of the claims.

Respectfully submitted,

A handwritten signature in cursive script, reading "Christina Geerlof", written over a horizontal line.

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9. CLAIMS APPENDIX

Claims 1-21 (canceled)

22. A product having a center layer of a semi-liquid material, an intermediate layer of a gum material and an outer layer of a hard candy material.
23. The product as recited in claims 22 wherein said liquid material includes Pectin as one of its ingredients.
24. The product as recited in claim 22 wherein said product is made by a process including the steps of extruding said gum material from an extruder, injecting said liquid material into said extruded gum material, coating said semi-liquid-filled gum material with a candy material, and forming said candy coated semi-liquid-filled gum material into a lollipop product.

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10. EVIDENCE APPENDIX

There were no declarations or other evidence submitted during the prosecution of this application.

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11. RELATED PROCEEDINGS APPENDIX

No related appeals or interferences are known to Appellants or Appellants' legal representative which will directly affect or be directly affected by or have bearing on the Board's decision in this appeal.